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| In re Application of | : | DECISION |
| PRELAS et al. | : | |
| Application No.: 09/600,279 | : | |
| PCT No.: PCT/US99/00380 | : | |
| Int. Filing Date: 15 January 1999 | : | |
| Priority Date: 16 January 1998 | : | |
| Attorney Docket No.: Q43649 | : | |
| For: SOLID STATE ELECTRIC GENERATOR | : | |
| USING RADIONUCLIDE-INDUCED EXCITON | : | |
| PRODUCTION | : | |

This is a decision on applicants' "SUBMISSION IN RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF DECISION OF PETITION UNDER 37 CFR 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 26 October 2001.

BACKGROUND

On 15 January 1999, applicants filed international application PCT/US99/00380, which claimed a priority date of 16 January 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 22 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 August 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 July 2000 (16 July 2000 being a Sunday).

On 14 July 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 04 August 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a one-month extendable period for reply.

On 05 February 2001, applicants submitted a petition under 37 CFR 1.47(a), which was

accompanied by, *inter alia*: a petition for a five-month extension of time; the fee for a five-month extension of time; the surcharge under 37 CFR 1.492(e); a series of declarations executed by four of the five joint inventors; a copy of several e-mails; and a copy of a letter sent to the non-signing joint inventor.

On 23 May 2001, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor could not be found or reached after diligent effort had not been provided, nor had a proper oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor been provided.

On 18 July 2001, applicants submitted a "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 CFR 1.47(a)" which was accompanied by a declaration of inventors signed by the previously nonsigning inventor Allister Dann.

On 27 September 2001, the USPTO mailed a decision dismissing applicants' petition for status under 37 CFR 1.47(a) as moot because a declaration of inventors has been executed by the previously nonsigning joint inventor. It was also noted that a new declaration signed by Mark A. Prelas was required since the declaration executed by him filed on 05 February 2001 failed to identify all the inventors as required by 37 CFR 1.497(a)-(b). It was also noted that the declaration signed by Mr. Jennings did not comply with 37 CFR 1.497(a)-(b) because the difference in the names of the inventor in the published international application (Howard J. Jennings in the published international application and the declarations signed by all of the joint inventors except Howard Jennings) and the declaration signed by Mr. Jennings (Howard T. Jennings) had not been explained.

On 26 October 2001, applicants submitted the instant "SUBMISSION IN RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF DECISION OF PETITION UNDER 37 CFR 1.47(a)," which was accompanied by a declaration of inventors signed by Mark Prelas and an explanation of the difference in the middle initial of Mr. Jennings in the published application and the declaration signed by him.

DISCUSSION

The response filed 26 October 2001 concerns the correction of an inventor's name and notifies the Office that the correct spelling of the inventor's name is as follows: **Howard T. Jennings** as indicated in the declaration filed 05 February 2001 rather than Howard J. Jennings, as is indicated in the international application. The response explains that the international application contained a typographical error concerning the middle initial of Mr. Jennings' name.

Applicants' explanation of the difference in the spelling of Howard T. Jennings' name is accepted and noted for the record.

The declaration signed by Mark Prelas submitted on 26 October 2001 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the application a 35 U.S.C. 371(c) date of **26 October 2001**.



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